



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/977,644	11/24/1997	RALPH EMERSON	PROG.003.00U	3349

7590

11/07/2002

DAVID J. BREZNER,
FLEHR HOHBACH TEST ALBRITTON 7 herbert llp
4 embarcadero center, suite 3400
SAN FRANCISCO, CA 94111

EXAMINER

LEVY, NEIL S

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 11/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	977644	Applicant(s)	EMERSON et al
Examiner	NOTLEY	Group Art Unit	1616 24

--The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address--

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☐ Responsive to communication(s) filed on 6/20/02

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☐ Claim(s) 1, 4, 5, 7, 8, 10, 12-14, 16 & 18 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 4, 7, 8, 10, 12 & 14 is/are rejected.

☒ Claim(s) 5, 16 & 18 is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Receipt is acknowledged of amendment of 6/30/02.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 1, 4, 5, 7, 8, 10, 12-14, 16 and 18 are rejected as being based upon a defective reissue Declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

Claims 1, 4 and 5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 54, 56-62 of copending Application No. 08/479,623. Although the conflicting claims are not identical, they are not patentably distinct from each other because the rejection of record is maintained.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1, 4 and 5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8, 25, 29-39, 41, 57, 61, 66-69, 71-75, 77-86 of copending Application No. 08/860514. Although the conflicting claims are not identical, they are not patentably distinct from each other because the rejection of record is maintained.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1, 4 and 5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, 14-16, 29-33 of copending Application No. 08/860499. Although the conflicting claims are not identical, they are not patentably distinct from each other because the rejection of record is maintained.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1, 4 and 5 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 5-10, 12-14, 16, 17, 19-22 of copending Application No. 09/431542. Although the conflicting claims are not identical, they are not patentably distinct from each other because the rejection of record is maintained.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The 112 rejections, and double patenting over 5676958 (now obvious) have been withdrawn in view of amendments of 6/20/02. Thank you.

Claims 1, 4, 5 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Examiner fails to find support in the specification for ANTS, as now claimed at claim 1, and, particularly, at claim 4, requiring 70% kill.

Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is no bait composition per se, thus, arachnids are not seen as included in those pests known, and so identified, as controllable with baits (See page 8—termite, cockroach, flies—"known in the art-" at lines 19, 20 but not fleas, mites-line 20["]—in addition to-bait-".

Examiner suggests removing arachnids or identifying support for mite or spider bait coupled to a solid support.

Claims 7, 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Howell et al 5102675.

The rejection of record is maintained. The claim is to a composition suitable for use as bait. The Howell composition (column 1, lines 31-35) is wood chips—not^t unknown as suitable termite bait-with coniferaldehyde present. The coniferaldehyde is in the oak—a cellulose material (claim 12), reversibly coupled, (claim 13) since it comes out, when put in wine. Applicants arguments of 2/14/02 are not persuasive; applicant is encouraged to show oak is not a termite-suitable bait, to overcome this rejection. The compositions require no more than suitability as bait; they are not claimed as a bait, in other words, an attractant, because of the presence of cinnamic or coniferyl aldehyde; presumably because applicant has no showing of such attractancy to arachnids, termites, cockroach or fly—whether associated with the field of pest control, or not (it's not) Howell has the instant composition, so we give no patentable weight to the implied methods. We will concede it would not^{be} reasonable to find these species enter, and leave, the casks Howell puts the chips in. We withdraw the rejection of claims 16 and 18 over Howell, because weight is given to enablement for one in the art to provide fly, cockroach and termite bait formulations; Howell would be operative by the pest diving into the barrel, but not leaving.

Claims 8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Armstrong--5149715.

The rejection of record is maintained. Future intended use as soap or shampoo is not given patentable weight. Since the cinnamic aldehyde concentrations are in accord with those of the instant specification, if the composition were to be applied to places where, and examined for, its effect on the claimed pests, the results would be as instantly disclosed—70% dead pests.

We find no solid support for bait compositions for the now claimed species, in Metcalf—the rejection is withdrawn, so is the Ando rejection, in view of applicant's arguments of 2/14/02 and amendments of 6/20/02.

Claims 8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Dorman.

The rejection of record is maintained. See claim 2—an emulsifying agent, thus—detergent—with cinnamic aldehyde kills insects (column 3, line 50) spiders. There are no (instant claim 10) antioxidants. Dorman does not specify aqueous composition, so those claims are no longer rejected, under 102 Dorman.

Claims 8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Berk et al 4525480.

The rejection of record is maintained.

See claim 18 of Berke: cinnamaldehyde in a shampoo is the instant composition; its up to 0.067% of cinnamic aldehyde (2:1); thus sufficient to kill not only the claimed microbes, but, if used as shampoo, insects, since that is the composition and concentration the instant invention provides, to kill 70%. Column 1, line 60-line 11,

Art Unit: 1616

column 2; further provides 74% cinnamaldehyde, in aqueous composition, with detergent (propylene glycol), without antioxidants.

Claims 1, 4, 8, 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Saotome—FR 2529755.

The translation shows (page 6) 10% cinnamic aldehyde, propylene glycol and water—this is the instant composition of claim 1 and 8; the propylene glycol a detergent—if used directly, would kill 70% as that is the concentration of the instant invention, when applied (sprayed) on crops, to kill harmful insects (page 7, paragraph 3). Other additives, surfactants can be present (page 8, top) (page 9, top) 99% white flies were killed (Example 4). Applicant's arguments are not persuasive; Saotome uses the instant methods and compositions of aqueous cinnamaldehyde to kill insects, including flies (See claims 1, 2, 6, 8 and 9).

Claims 8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Sperti et al 4477361.

The claim is now limited to soap or detergent formulations and cinnamic or coniferyl aldehyde. Sperti provides 0.3% cinnamic aldehyde (column 3, line 40-50) this is the instant composition. Inherently, if insects were present, it would do what the instant composition would do: kill them.

Applicant's arguments filed 7/20/02 and 2/14/02 have been fully considered but they are not persuasive. Applicant's arguments have been addressed above; arguments for amendment to claim 1 are not persuasive; we find no ants, nor are any argued for at

column 5, lines 55-column 7, line 50 or at column 3. claim 7 is to bait; the argued support is to contact treatment, not bait.

Claims 5, 16 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil Levy whose telephone number is 308-2412. The examiner can normally be reached on Tuesday- Friday 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on 308-4628. The fax phone numbers for the

Application/Control Number: 08/977,644

Page 9

Art Unit: 1616

organization where this application or proceeding is assigned are 305-4556 for regular communications and 305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1235.

Levy: mv
November 5, 2002

A handwritten signature in black ink, appearing to read "Neil S. Levy". The signature is fluid and cursive, with the first name "Neil" and last name "Levy" clearly distinguishable.

NEIL S. LEVY
PRIMARY EXAMINER